

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1, 2, 4-6, 8, 9, 11-16, 19, 21-24, 36 and 37 are pending. Claims 3, 7, 10, 17, 18, 20 and 25-35 have previously been cancelled without prejudice or disclaimer. Claims 1 and 15 are independent. Claims 1 and 15 have been amended by way of this Amendment/Response; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicants submit that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation application(s). Applicants submit that these claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1, 2, 4-6, 8, 9, 11-16, 19, 21-24 and 36-37 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Per claims 1 and 15, the Examiner alleges:

Claims 1 and 15 provides for "using the sale of the trust certificate to the first entity, combined with the purchase of the equity security by the trust and the purchase of the put option by the trust, so as to provide the first entity with principal protection exposure to the equity market without causing substantial income statement volatility", but does not set forth any steps involves in the method/process for doing so. It is unclear what method/process applicant is intending to

encompass with this 'use' recitation. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

(p. 2, § 2, Office Action)

Applicants respectfully disagree and submit that the claim elements recited in independent claims 1 and 15 are clear and definite per 112, 2nd paragraph.

Applicants have amended claim 1 to further clarify the relationship between claim elements. Should the Examiner maintain the rejections, Applicants respectfully request clarifications as to how the noted claims would be indefinite when considered within the context of the claim taken as a whole. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection with regard to independent claims 1 and 15.

With regard to claims 2 and 16, the Examiner further alleges that "These claims recite an intended result, but provide no positive steps for accomplishing this result and are, therefore, indefinite since they merely recite an intended result without any active, positive steps delimiting how this result is actually accomplished" (p. 3, ¶ 1, Office Action). Applicants respectfully disagree, and note that claim 2 and 16 are dependent from independent claims 1 and 15, respectively. Applicants submit that the dependent claims are properly configured and include additional details related to elements discussed in the claims. By way of example only, dependent claim 2, further details aspects of the "principal protection exposure" recited in independent claim 1, wherein the "principal protection exposure is provided to the first entity with substantially no income statement volatility." As such, Applicants submit that claims 2 and 16 are clear and definite per 35 U.S.C. 112, 2nd paragraph, and request reconsideration and withdrawal of these grounds of rejections.

Although of different scope than claims 1-2 and 15-16, Applicants submit that claims 4-6, 8-9, 11-15, 19, 21-24 and 36-37 are clear and definite for at least the similar reasons to those

discussed above. Accordingly, Applicants respectfully request withdrawal of these grounds of rejections.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 4-6, 8, 11-16, 21-24 and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over Securities Act File No. 333-83085 filed by The Market Participation Principal Protection Fund Inc, July 16, 1999 (hereinafter "SEC"), in view of Hecht v. Malley, 265 U.S. 144 (1924) (hereinafter "Hecht"), in further view of U.S. Pub No. 2002/0138396 A1 to Brown, filed Mar 21, 2001 (hereinafter "Brown"; the Examiner stated U.S. Pub "2002/0138391 A1", which Applicants believe it is typographical and should be 2002/0138396), in further view of Trudy Ring's Article Abstract 'European' Settlement draws Funds' Interest, published in Pension & Investment Age, May 12, 1986, vol 14, Iss 10, pg 41-42, retrieved from Proquest 7/2/2008 (hereinafter "Ring"). The Office Action further rejected claims 9 and 19 under 35 U.S.C. § 103(a) as being unpatentable over SEC in view of Hecht, Brown, Ring and US Patent 5,809,484 to Mottola, 1998 (hereinafter "Mottola"). Although Applicants respectfully traverse these rejections and submit that the Examiner has not established a *prima facie* case of obviousness, Applicants have amended independent claims 1 and 15 to provide further clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the pending rejection has failed to properly establish at least the first two requirements presented above, and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each claim.

Independent claim 1 recites, *inter alia*:

A computer implementable method, comprising:
selling ... a trust certificate to generate proceeds,
wherein the sale is from a trust to a first entity;

...

purchasing ... the equity security with the allocated
portion of the proceeds of the sale of the trust certificate,
wherein the purchase is made by the trust from an equity
market;

...

purchasing ... the put option with the allocated portion
of the proceeds of the sale of the trust certificate, wherein the
purchase is made by the trust from a second entity based on
the details associated with the purchase of the equity security;
and

providing ... the first entity with principal protection
exposure to the equity market without causing substantial
income statement volatility based on the sale of the trust
certificate to the first entity, wherein the trust certificate
provides the first entity with an interest in the trust, wherein
the trust invests the trust certificate proceeds in the purchase
of the equity security and the purchase of the put option
based on the details associated with the purchase of the
equity security;

...

In the pending rejection, the Examiner alleges SEC discusses:

purchasing ... the equity security with the allocated
portion of the proceeds of the sale of the trust certificate,
wherein the purchase is made by the trust from an equity
market ("With the remaining proceeds, the Fund will invest in a
portfolio that will match as closely as practicable the

composition and proportions of the S&P 500 Index.", See [SEC]...);

purchasing ... the put option with the allocated portion of the proceeds of the sale of the trust certificate, wherein the purchase is made by the trust from a second entity ("With the proceeds of this offering, the Fund intends to purchase one or more Put Contracts related to the S&P 500", See [SEC]...)

...provide the first entity with principal protection exposure to the equity market ("The investment objective of the Fund is to return to shareholders on or about the Maturity date ... the Fund's initial net value", See [SEC] ...)...
(pp. 4-5, Office Action)

Applicants respectfully disagree and submit that SEC does not teach at least the cited claim elements "purchasing ... the equity security" and "purchasing ... the put option ... based on the details associated with the purchase of the equity security."

Instead, Applicants note that the Examiner's cited portions of SEC discuss two transactions:

(1) "With the proceeds of this offering, the Fund intends to purchase one or more Put Contracts related to the S&P 500" (Examiner's Annotation 2, SEC); and then

(2) "With the remaining proceeds, the Fund will invest in a portfolio that will match as closely as practicable the composition and proportions of the S&P 500 Index" (Examiner's Annotation 2, SEC).

Applicants submit SEC's purchase of "Put Contracts related to the S&P 500" and the subsequent purchase of "a portfolio that will match ... S&P 500 Index" are in direct contrast to the claimed "purchasing ... the equity security" and "purchasing ... the put option ... based on the details associated with the purchase of the equity security" as recited in independent claim 1. As such, Applicants submit that the Examiner fails to establish a *prima facie* case of obviousness.

In the pending rejection, the Examiner acknowledges SEC does not discuss the claimed "selling ... a trust certificate to generate proceeds ..." (p. 5, Office Action), and turns to Hecht to remedy this deficiency in SEC. However, Applicants submit that Hecht's trust certificate transaction does not remedy the deficiencies identified in SEC with regard to the claimed "purchasing ... the equity security" and "purchasing ... the put option ... based on the details associated with the purchase of the equity security" as recited in independent claim 1 discussed above.

In view of at least the deficiencies discussed above, Applicants submit that the pending rejection has dissected the claims and evaluated obviousness of claim elements in isolation instead of in relation to the claim as a whole, in violation of MPEP § 2106 II C, which prescribes that "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." MPEP § 2141.02 I prescribes that "the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (original emphasis). Applicants submit that the claims have been impermissibly dissected and that a *prima facie* showing of obviousness has not been made. Should the Examiner disagree and maintain the rejection, Applicants respectfully request clarification as to how and specifically why the Examiner believes a combination of SEC and Hecht would have been obvious to one of ordinary skill in the art at the time of the invention as well as, how the alleged combination could result in the claimed elements including "providing ... the first entity with principal protection exposure to the equity market ... based on the sale of the trust certificate to the first entity, wherein the trust certificate provides the first entity with an interest in the first entity, wherein the trust invests the trust certificate proceeds in the purchase of the equity security and the purchase of the put option" as recited in independent claim 1.

As claims 2, 4-6, 8-9 and 11-14 are directly or indirectly dependent from independent claim 1, Applicants respectfully request reconsideration and withdrawal of these claims for at least similar reasons to those with regard to independent claim 1 discussed above identifying deficiencies in the cited references. Although of different scope than independent claim 1, Applicants submit that independent claim 15 and claims 16, 19, 21-24 and 36-37 directly or indirectly dependent therefrom, Applicants submit that these claims are patentably distinct from the various cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of these grounds of rejections.

Conclusion

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1, 2, 4-6, 8, 9, 11-16, 19, 21-24, 36, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicants assert that all such remaining and not discussed claim

elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-515. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized and requested to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-515.

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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